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In re Application of
Andrew C. Hiatt, et al
Application No. 08/434,000
Filed: May 4, 1995
Attorney Docket No. 212/127

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: DECISION ON PETITIONS UNDER
: 37 CFR 1.48(a) AND 1.183
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This is a decision on May 18, 1999 petitions under 37 CFR 1.48(a), requesting correction of the inventorship and under 37 CFR 1.183, requesting waiver of a requirement under 37 CFR 1.48(a)(2), and on the paper of October 15, 1999 filed in support thereof, which timely responds to a September 13, 1999 Requirement for Information.

The §1.48(a) petition to correct inventorship is Granted.

The petition under 37 CFR 1.183 is Granted.

Background

The Requirement for Information:

- noted the request to add Mostov as an inventor, and
- required:
 - compliance with § 3.73(b) for written consents of assignees submitted by King's College London (the consent did not refer to an attached assignment document), and Planet Biotechnology (no assignment document was submitted), and
 - original named inventor Hiatt to execute a § 1.63 declaration in compliance with § 1.63(e) with the new inventive entity to notify Hiatt of a duty of disclosure under § 1.56 for CIP applications (which was omitted from his original § 1.63

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declaration), and to provide notice to him of the intent to add an inventor.

The response of October 15, 1999 has submitted:

- a new written consent of King's College London that refers to attached Assignment documents,
- a Declaration on behalf of Planet Biotechnology stating:
 - there is no U.S. assignment to Planet Biotechnology by Hiatt (para. 3), and
 - that Hiatt was asked to sign a Declaration in compliance with §§ 1.56 and 1.63 and refused to do so (paras. 4 and 6).

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Decision on Petition Under 37 CFR 1.48(a)

In view of the submission of the written consent of King's College of London in compliance with § 3.73(b), Planet Biotechnology not apparently being an actual assignee, and the grant of the Petition under 37 CFR 1.183, *infra*, no outstanding issue exists.

The § 1.48(a) petition is Granted.

Decision on Petition Under 37 CFR 1.183

In view of the refusal of Hiatt to execute a new § 1.63 declaration appropriate for the instant CIP application with the correct inventive entity set forth, waiver of § 1.48(a)(2) and reexecution of a § 1.63 declaration by Hiatt is appropriate.

The petition under 37 CFR 1.183 is Granted.

The application is being returned to the Initial Patent Examination Division of the Office of Initial Patent Examination for further processing, including issuance of a corrected filing receipt, with the names of the four inventors as shown on the two executed declarations under 37 CFR 1.63 filed on May 18, 1999.



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